REMARKS

The Final Office Action has been carefully reviewed, and applicants now again request favorable reconsideration and allowance. The claims in the application, upon entry of the amendment above and the attached RCE, are claims 1, 2, 10-11, 13-20 and 23-28.

The main claims 1, 11, 13 and 15 have been amplified above, support being found in claims 3 and 4, wherein the second alternative of claim 3 is combined with inorganic material specified in claim 4, with the exception of titanium oxide. Further support can be found at page 4, lines 14-17 of the specification. Support for the layer thickness appears at page 4, line 27 of the specification.

New claims 23-28 have been added, these being parallel to claims 19 and 20, but instead being dependent from the other independent claims 11, 13 and 15. These new claims are patentable for the same reasons as the other claims, as pointed out below.

Prior to addressing the rejections individually, applicants wish to respectfully point out that there is an important and fundamental error in the application of the prior art, and this concerns the purity of the metals to be

used. In the absence of the references specifying metal purities, it must be understood that there is nothing unusual in the purity of the metals selected. None of the prior art documents, e.g. Reisser, mentions impurities. Therefore, it must be considered that the metals used for the production of metal effect pigments have the conventional purity, i.e. a so-called "technical" purity, i.e. they are not absolutely pure. For example, aluminum has a technical or normal purity in the range of 99.5 to 99.9 % by weight. Therefore, the impurities remaining in such normal aluminum range from 1000 to 5000 ppm, i.e. 5000 ppm for an aluminum purity of 99.5%, to 1000 ppm of impurities for aluminum having a purity of 99.9% by weight.

Contrary to the references applied, the metals used in the present invention have a much higher degree of purity, i.e. the indicated impurities are less than 100 ppm.

The PTO has no authority to make an assumption which is incorrect and untrue. The PTO cannot rely on inherency unless the inherency is "reasonably certain", and the law is very clear on this point. No only is the claimed purity not "reasonably certain" from the cited references, but it is absolutely not correct, as those skilled in the art of the production of metallic effect pigments simply did not use metals having such a high purity prior to the present invention.

An object of the present invention was to provide metal effect pigments which can be used in the field of cosmetics and which are especially resistant against sweat and saliva. The present inventors surprisingly found that it is possible to provide metal effect pigments having a particular resistance against sweat and saliva and are encapsulated in a thin layer of a barrier material.

The thinner the barrier layer the higher is the coverage of the metal effect pigments. The coverage is conferred by the plate-like metallic particle. Applying a (transparent) barrier layer normally leads to a reduced coverage. But in the present case it was surprising found that a thin barrier layer can be used, thereby maintaining the coverage of the metal effect pigments, and simultaneously providing the required resistance against sweat and saliva.

The present invention is both novel and non-obvious. The unique combination of features cannot be found in the prior art, and therefore novelty is present; and such combination of features would not have been obvious from any known prior art.

Claims 1-5, 8, 16, 19 and 20 have been again rejected as anticipated by Reisser. The rejection is again respectfully traversed.

Reisser does not disclose aluminum effect pigments wherein the aluminum platelets have the indicated purity and which are encapsulated by a barrier layer having a thickness in between 20 to 50 nm. As already noted above, the aluminum used for the production of the aluminum effect pigments according to Reisser are of technical purity, i.e. Reisser does not anticipate the aluminum purity recited in applicants' claims.

Moreover, the aluminum effect pigments of Reisser are encased in a layer of metal oxide which contains at least one color pigment (see, for example, claim 1 of Reisser). The resistance against sweat and saliva, which are very aggressive media, is significantly impaired by the incorporation of the color pigments into the metal oxide layer.

As it has been made clear that the barrier layer used in the metal effect pigments of the present invention consists of the indicated inorganic materials, the metal effect pigments of the present invention are clearly novel over Reisser.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1 and 18 have been again rejected as anticipated by Souma. This rejection is respectfully traversed.

According to Souma, the aluminum effect pigments are coated with titanium oxide. As titanium oxide is no longer claimed among the inorganic materials used in the production of the barrier layer of the present invention, Souma does not anticipate any of applicants' claims.

Withdrawal of the rejection is in order and is respectfully requested.

Claim 17 has again been rejected as obvious under Section 103 from Reisser in view of Nadkarni. The rejection is again respectfully traversed.

Reisser is fundamentally deficient relative to the present invention for the reasons pointed out above. Nadkarni does not make up for such deficiencies, and has not been cited for that purpose. Therefore, even if the combination were obvious, not conceded by applicants, the resultant reconstruction of Reisser in view of Nadkarni would not reach the subject matter of claim 1, let alone claim 17 which depends on and incorporates the subject matter of claim 1.

Withdrawal of the rejection is in order and is respectfully requested.

In part (6) starting near the bottom of page 4 of the Final Action, the PTO states that claims 1, 11-13 and 15 are product-by-process claims. This is not entirely correct, because such claims are clearly not pure product-by-process claims in that they recite features which have nothing to do with the method by which the claimed subject matter is made. Applicants wish to make two points as regards product-by-process claims: (1) such claims are perfectly permissible and do call for a product even if they are pure product-by-process claims; (2) the process language of any claim must be given full weight insofar as such process language serves to characterize the product being made.

On this second point, attention is respectfully invited to *In re Luck et al*, 177 USPQ 523, 525(CCPA 1973) in which the Court stated:

> As for the method of application, it is well established that product claims may include process steps to wholly or partially define the claimed product. [citation omitted]. To the extent these process limitations distinguish the ***product*** over the prior art, they must be given the same consideration as traditional product characteristics. [emphasis in original]

Thus, to the extent that any process recitation serves to characterize the product, the PTO may not properly ignore such a recitation.

Claims 1, 7 and 10 have been rejected under Section 102 as anticipated by Souma. This rejection also is respectfully traversed.

Souma has been described above. It does not anticipate any of applicants' claims for the reasons pointed out above.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 11, 12, 16, 21 and 22 have been rejected under Section 102 as anticipated by Saha et al USP 3,389,116 (Saha). This rejection is respectfully traversed.

According to the teaching of Saha, the coating of polymerized n-(trimethoxysilylpropyl) ethylenediamine allows one to apply these pigments by electrostatic spraying (col. 1, lines 29 to 33). However, the coating of pigments of Saha is very different, indeed critically different, from the coating of the pigments of the present invention. Moreover, the pigments of Saha cannot be used in cosmetic applications as the compound n-(trimethoxysilylpropyl) ethylenediamine is irriating to eyes and skin. Enclosed please find a safety data sheet of Degussa AG regarding Dynasylan® DAMO which is n-(trimethoxysilylpropyl) ethylenediamine, proving that fact.

Applicants' claims do not correspond with and are not covered by the disclosure of Saha, and Saha does not

anticipate any of applicants' claims. Withdrawal of the rejection is in order and is respectfully requested.

Claims 13 and 14 have been rejected under Section 102 as anticipated by Chida et al USP 5,037475 (Chida). Similarly, claim 15 has been rejected under Section 102 as anticipated by Bolger et al USP 3,389,105 (Bolger). These rejections are respectfully traversed.

Both Chida and Bolger disclose metallic pigments coated with an organic coating. Applicants no longer claim an organic coating, and applicants' claims indeed exclude any coating which could be validly called an organic coating.

Withdrawal of these rejections is in order and is respectfully requested.

No rejections have been imposed under Section 103 except for the repeated rejection of claim 17 as obvious from Reisser in view of Nadkarni, traversed above. Setting aside that one rejection, already responded to, applicants agree with the implication of the Office Action that applicants' claims would not have been obvious from any of the known prior art, including those references applied under Section 102, either alone or in view of any known secondary art. In particular, applicants respectfully note that there is nothing in the prior art which would have given any reason for one

skilled in the art to use the indicated metals in the indicated purities together with the indicated inorganic coating having a thickness of 20 to 50 nm in order to provide metal effect pigments particularly resistant against sweat and saliva, and still obtain excellent coverage.

Applicants submit that they have address above all issues raised in the final action, whereby the present application should now be in condition for formal allowance. Favorable reconsideration and allowance are earnestly solicited.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By _____
Sheridan Neimark
Registration No. 20,520

SN:tdd
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\L\Louk\kaupp1\pto\2008-01-10AMDFNLFRM.doc